

### **Remarks**

Claims 21-44 are currently pending in this application. Claims 21-44 have been rejected. Claims 21-24, 30, 31 and 43 have been amended with this Response.

#### **Claim Amendments**

Claims 21-24, 30, 31 and 43 have been amended with this Response. Support for these claim amendments can be found, for example, in Figures 9 and 10 and the description accompanying these figures. As an example, element 420 can be described as either the capture member or the retaining means recited in the amended claims. No new matter has been added as a result of these claim amendments.

#### **Claim Rejections Under 35 U.S.C. §112**

Claims 22-24 and 30 are rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. It was asserted that claims 22-24 and 30 have a double inclusion of a claim element, and a word in claim 24 should be made plural. These claims have all been amended to eliminate these issues, and Applicants assert that these claims are in condition for allowance.

#### **Claim Rejections Under 35 U.S.C. § 102**

Claims 21-23, 27-29, 31, 32, 34-39 and 41-44 are rejected under 35 U.S.C. §102(e) as being anticipated by Bosma et al., U.S. Patent No. 6,241,746) (hereinafter “Bosma”). Applicants respectfully traverse this rejection. In order for a reference to anticipate a claim, each and every element of that claim must be present in the reference. See M.P.E.P. §2131.

Bosma discloses a vascular filter convertible to a stent. As shown in Figures 1-4A, the vascular filter 10 can apparently have pins 26 and clamps 22 that can be separated from the vascular filter 10. With the pins 26 and clamps 22 separated from the vascular filter 10, the filter 10 can apparently expand as shown in Figures 2 and 3, and the pins 26 and clamps 22 can apparently be pulled out through a catheter. See column 3, lines 58-61.

In contrast, claim 21 recites, in part, a selectively releasable retainer disposed on filtering strands and a catheter, the catheter having a lumen and a capture member. The catheter is configured to engage the selectively releasable retainer and the capture member is configured to retain the retainer within the catheter lumen when the retainer has been released. Nothing in Bosma appears to disclose a capture member that is configured to retain a retainer within the lumen of a catheter when the retainer has been released. Because at least this element of claim 21 does not appear to be present in Bosma, Applicants respectfully assert that this claim is allowable over this reference. Because they are dependent on claim 21 and because they contain additional patentably distinct elements, Applicants also assert that claims 22, 23 and 27-29 are allowable over this reference.

Claim 31 recites, among other elements, a thrombus filter comprising a retainer releasably attached to the distal ends of filtering strands and a catheter, the catheter having a lumen and a capture member. The catheter is configured to engage the retainer and the capture member is configured to retain the retainer within the lumen of the catheter when the retainer has been released. Again, Bosma does not appear to disclose a capture member that is configured to retain a retainer within the lumen when the retainer has been released. Because at least this element of claim 31 does not appear to be disclosed in Bosma, this reference cannot anticipate this claim. Because they are dependent on claim 31 and because they contain additional patentably distinct elements, Applicants also assert that claims 32 and 34-37 are also allowable over this reference.

Claim 38 was also rejected as being anticipated by Bosma. Applicants respectfully disagree with this rejection. 35 U.S.C. §112, sixth paragraph states that means plus function claims are to be “construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof” (emphasis added). When interpreting means-plus-function language, the claim language should be interpreted in light of the structure that is included in the specification. See M.P.E.P. §2181.

Claim 38 recites, in part, a retaining means for maintaining the retainer within the catheter when the retainer is removed from the distal ends of the filtering strands. At least one structure (e.g., element 420 in Figures 9 and 10) is disclosed as such a retaining

means. Bosma does not appear to disclose a structure that performs such a function, and as such Bosma does not anticipate claim 38. For at least this reason, Applicants respectfully assert that this claim is allowable over this reference. Because they are dependent on claim 38 and because they recite additional patentably distinct elements, Applicants also assert that claims 39, 41 and 42 are allowable over Bosma.

Further, Applicants assert that a *prima facie* case has not been made that any structure described in Bosma is the equivalent of the means plus function structure recited in claim 38. M.P.E.P. §2183 states that “the examiner should provide an explanation and rationale in the Office action as to why the prior art element is an equivalent” (emphasis added). Applicants note that the means plus function language of claim 38 is not compared to anything at all in the Office Action, and as such a *prima facie* case of equivalence cannot possibly have been established. For at least the above reasons, Applicants assert that claim 38, and dependent claims 39, 41 and 42 are not anticipated by Bosma.

Claim 43 recites, among other elements, a means for controlling the shape of the filtering region and a catheter, the catheter including a retaining means for maintaining the means for controlling the shape of the filtering region within the catheter. Applicants again point out that the means plus function elements have not been compared to any structure in Bosma, and as such a *prima facie* case of anticipation has not been established with respect to claim 43. Further, Bosma does not appear to disclose a catheter with a retaining means. Because Bosma is missing at least this portion of claim 43, this claim is allowable over this reference.

Claim 44 recites, in part, a retainer releasably attached to the distal ends of the filtering filaments and a catheter configured to engage the retainer, the catheter including a retaining means for maintaining the retainer within the catheter when the retainer is removed from the distal ends of the filtering elements. Again, Applicants point out that the means plus function elements have not been compared to any structure in Bosma, and as such a *prima facie* case of anticipation has not been established with respect to claim 44. Further, Bosma does not appear to disclose a catheter with a retaining means. Because Bosma is missing at least this portion of claim 44, this claim is allowable over this reference.

### **Claim Rejections Under 35 U.S.C. § 103**

Claims 24-26, 30, 33, 40 are rejected to under 35 U.S.C. § 103(a) as being unpatentable over Nott et al., U.S. Patent No. 5,709,704 (hereinafter “Nott”), apparently in combination with O’Connell, U.S. Patent No. 6,267,776. Applicants respectfully traverse this rejection. In order for a combination of references to render a claim obvious, each and every element of the claim must be present in the combination. See M.P.E.P. §2143.03.

As mentioned above, claim 21 recites, in part, a selectively releasable retainer disposed on the filtering strands and a catheter, the catheter having a lumen and a capture member. The catheter is configured to engage the selectively releasable retainer and the capture member is configured to retain a retainer within the lumen when the retainer has been released. Claim 31 recites, among other elements, a thrombus filter comprising a retainer releasably attached to the distal ends of the filtering strands and a catheter, the catheter having a lumen and a capture member. The catheter is configured to engage the retainer and the capture member is configured to retain the retainer within the lumen of the catheter when the retainer has been released. Further, claim 38 recites, in part, a retaining means for maintaining the retainer within the catheter when the retainer is removed from the distal ends of the filtering strands.

Neither Nott or O’Connell, or a combination thereof, appears to disclose structures that would retain anything with a catheter as recited in claims 21, 31 and 38. As such, all elements of these claims are not disclosed in this combination of references. Because they are dependent on claims 21, 31 and 38 and because they contain additional patentably distinct elements, Applicants assert that claims 24-26, 30, 33 and 40 are allowable over Nott and O’Connell.

Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are currently in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612-677-9050.

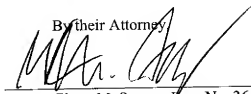
Respectfully submitted,

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By their Attorney

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